Remarks:

Claims 1 through 24 remain pending in the present application. The Patent Office has rejected claims 1-5, 8-21, and 24 and objected to claims 6, 7, 22, and 23 as being dependent upon a rejected claim base but would be allowable if amended. The Applicant thanks the Patent Office for noting the allowability of these claims. However the Applicant believes that all of the claims presently before the Patent Office are allowable as discussed below. As such the Applicant respectfully requests entrance of this amendment on the present application and requests an early notice of Allowance or other favorable action. Please charge any other prosecution fees, including a late payment fee which are due to Kimberly-Clark Corporation's Deposit Account No. 11-0875.

35 USC §101 Rejection for Double Patenting

Claims 1, 2, 4, 6-8, 11, 18, 20, and 22-24 were rejected under 35 USC §101 as being statutorily double patented with various claims of co-pending US Application 10/608,164.

The Applicant traverses this rejection on the basis that the Patent Office has failed to establish a prima facie case of statutory double patenting under 35USC §101. As such it is requested that the Patent Office withdraw the rejection. To establish a prima facie case of statutory double patenting, the Patent Office must analyze whether practicing one claim will literally infringe the other. Although similarities have been noted, no such analysis has been presented.

The present application is drawn to a method of measuring effort whereas co-pending US Application 10/608,164 is drawn to an apparatus. The method claimed herein comprises additional steps of mounting a glove, initializing equipment, and acquiring data, at least some limitations which are not contained within the 10/608,164 application. Moreover, the 10/608,164 application has been amended via a first Office Action to recite:

1. (Currently Amended) An apparatus for measuring the relative difficulty in donning of a glove comprising:

a glove mount adapted to hold a glove in an open donnable position, the glove mount moveable with respect to a fixed reference, wherein the glove mount comprises two opposed arms connected to one another at a first end of each and terminating at a second end of each in at least one glove seat; and

a device for measuring the effort associated with donning the glove.

Presently, the amended claim adds limitations not in the claims before the Patent Office on this application. Each of these reasons is sufficient in and of itself to moot the 35 USC §101 rejection. As such the Applicant respectfully submits that the co-pending applications are not subject to a statutory double patenting rejection under 35 USC §101.

35 USC §103 Rejection over US Patent 6,578,433 to Yakopson et al in view of US Patent 6,419,131 to Rix

The Patent Office has rejected claims 1-5, 8-21, and 24 as being obvious over the combination of Yakopson et al and Rix, namely it is held that Yakopson et al teaches an apparatus for measuring donning effort and Rix teaches a glove used for a donning apparatus.

The Applicant respectfully traverses this rejection on the basis that the Patent Office has not established a prima facie case of obviousness. To establish a prima facie case of obviousness using a combination of references, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art references, when combined, must teach or suggest all the claim limitations.

"There are three possible sources for a motivation to combine references: the nature of the problem to be solved, the teachings of the prior art, and the knowledge of persons of ordinary skill in the art." The level of skill in the art cannot be relied upon to provide the suggestion to combine references. Moreover, none of these sources for motivation have been enumerated in the present case as pointed out below.

Yakopson et al. seeks to establish:

> a method for evaluating the donning properties of hosiery and a device which can be used to perform the method. More specifically, the invention relates to a method for simulating and measuring frictional and compressive forces that a patient would experience when donning a stocking, and an apparatus for measuring those forces.

See for example the Field of the Invention recited by Yakopson et al. at column 1, lines 13-19. In contrast Rix relates to a "glove donning apparatus for use by a person in the donning of a glove with a single hand, including the donning of elastic medical gloves with a single hand." See Rix at column 1, lines 2-8.

The nature of the problems is completely different. Yakopson et al is specifically designed for measuring frictional and compressive forces associated with donning tubular articles, namely hosiery, whereas nothing in Rix suggests the need for either qualitative or quantitative data on donning. It is not apparent to the Applicant how the nature of these two problems is similar enough to enable one skilled in the art to combine their teachings.

Neither reference teaches the solutions of the other. Moreover, neither of the references even identify the problem the Applicant seeks to address in the pending application. While the theoretical person of skill in the art is deemed to have knowledge of all existing solutions, that person is not under a similar accountability to have knowledge of unidentified needs or problems. It is not until the existence of the present invention that any link between these

disparate concepts is made. Without more, these conclusions seems to be a classic example of hindsight reconstruction.

As such the Applicant maintains that a prima facie case of obviousness with respect to Yakopson et al and Rix has not been met and the rejected claims are not obvious in view of the combination of Yakopson et al and Rix.

The Applicant thanks the Patent Office for its review of this matter and respectfully submits that the present claims are in condition for allowance and as such requests an early notice of Allowance or other favorable action. Please charge any prosecution fees including the fee for one month's extension which are due to Kimberly-Clark Corporation's Deposit Account No. 11-0875. **The Examiner is invited to telephone the undersigned at their convenience to discuss any minor issues which may remain after consideration of the present amendment.**

Respectfully submitted,

Audra S. Wright et al

By: _____

Scott B. Garrison, Reg. No. 39,198
770-587-8621
Kimberly-Clark Corporation
401 North Lake Street
Neenah, Wisconsin 54956

CERTIFICATE OF MAILING

I, Laura L. Rubino, hereby certify that on Thursday, December 02, 2004, this document is being facsimile transmitted to the United States Patent and Trademark Office Fax No. 703-872-9306.

_____
Laura L. Rubino